

ESTTA Tracking number: **ESTTA19827**

Filing date: **11/22/2004**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	RE/MAX International, Inc.
Granted to Date of previous extension	11/21/2004
Address	8390 East Crescent Parkway Suite 600 Greenwood Village, CO 80111-2800 UNITED STATES

Attorney information	Shelley K. Barton Greenberg Traurig LLP 1200 Seventeenth Street, Suite 2400 Denver, CO 80202 UNITED STATES bartons@gtlaw.com, posthumusj@gtlaw.com, bourassas@gtlaw.com Phone:303-572-6500
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Applicant Information

Application No	75983359	Publication date	05/25/2004
Opposition Filing Date	11/22/2004	Opposition Period Ends	11/21/2004
Applicant	ROMAX TECHNOLOGY LIMITED Potterdike House Lombard Street		

	Newwark, Nottinghamshire, NG24 1XG, UNITED KINGDOM
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Goods/Services Affected by Opposition

<p>Class 009.</p> <p>All goods and sevicees in the class are opposed, namely: COMPUTER SOFTWARE FOR TRANSMISSION DYNAMICS SIMULATION, GEARBOX MODELING AND ANALYSIS AND SHAFTS, BEARINGS AND GEAR COMPONENT ANALYSIS; FLOPPY DISCS, HARD DISCS AND CD ROMS FOR COMPUTERS FEATURING DESIGN AND ANALYSIS OF TRANSMISSIONS, GEARBOXES, SHAFTS AND BEARINGS FOR GROUND VEHICLES; AND TEACHING APPARATUS, NAMELY, COMPACT DISCS AND COMPUTER PROGRAMS FEATURING MODELING AND ANALYSIS ENGINES TO VISUALIZE TRANSMISSION CONFIGURATIONS; AND COMPUTER GAME PROGRAMS</p>

Attachments	ROMAX 75 983359 Notice of Opposition 63529 016900.pdf (20 pages)
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Signature	/Shelley K. Barton/
Name	Shelley K. Barton
Date	11/22/2004

affiliated sales agents who are authorized to use Opposer's registered service marks in connection with real estate brokerage services.

2. Opposer, since at least as early as 1974, has provided real estate brokerage services in interstate commerce through brokerage offices owned and operated by it and, since at least as early as 1977, through its sub-franchisors, franchisees, and affiliated sales agents, all in connection with its distinctive registered service marks, "REMAX" and "RE/MAX". Opposer is the owner of U.S. Trademark Registration Nos. 1,139,014; 1,339,510; 2,403,626; and 2,468,858 for its mark "RE/MAX," and the owner of U.S. Trademark Registration Nos. 2,106,387 and 2,054,698 for its service mark "REMAX." (Exhibit A).

3. The common law and federal registration rights of RE/MAX are collectively referred to as the "RE/MAX marks."

4. The RE/MAX marks are used on a variety of advertising media including yard signs, business cards, newspapers and other print media, directional signs, open house signs, hot and cold air balloons, television commercials, billboards, bus stop benches, transit buses, moving vans, banners, brochures, coffee mugs and other advertising and promotional items.

5. Since at least as early as 1974, Opposer and Opposer's Affiliates have invested over two billion dollars to develop, promote and maintain the RE/MAX marks in the United States and worldwide. More specifically, Opposer's Affiliates have used the RE/MAX marks in connection with over nine million home sale transactions in the United States and worldwide, resulting in over one trillion dollars in sales volume from as early as 1974 to present date.

6. As a result of substantial sales and extensive advertising and promotion, the RE/MAX marks have become widely and favorably known as identifying real estate brokerage services originating from, sponsored by or associated with Opposer. Indeed, the RE/MAX marks are

famous. The public has to associate the RE/MAX marks as a source of high quality real estate brokerage services.

7. Applicant filed U.S. Trademark Application Serial No. 75/983,359 on April 1, 1998, seeking to register ROMAX as a word mark in connection with "computer software for transmission dynamics simulation, gearbox modeling and analysis and shafts, bearings and gear component analysis; floppy discs, hard discs and CD ROMs for computers featuring design and analysis of transmissions, gearboxes, shafts and bearings for ground vehicles; and teaching apparatus, namely, compact discs and computer programs featuring modeling and analysis engines to visualize transmission configurations; and computer game programs" in International Class 9.

8. Applicant's mark, ROMAX, when used in connection with the goods identified in Application Serial No. 75/983,359 is likely to cause confusion, or to cause mistake, or to deceive consumers as to an affiliation, connection or association between Opposer and Applicant, or as to the origin, sponsorship, or approval of Applicant's goods, services or other commercial activities.

9. Opposer's RE/MAX name and marks are of sufficient fame and reputation among consumers that, when Applicant's ROMAX mark is used in connection with the goods set forth in Applicant's Application, a false connection with Opposer will be presumed by consumers.

10. Applicant's ROMAX mark, when used in connection with the goods identified in Application Serial No. 75/983,359, is likely to dilute the distinctive quality of Opposer's famous RE/MAX marks.

11. Applicant's use of ROMAX for the services set forth in Application Serial No. 75/983,359 is not authorized by Opposer.

12. The registration of Applicant's ROMAX mark on the Principal Register would be inconsistent with Opposer's rights under the aforementioned registrations, the common law and the Trademark Act, and would be damaging to Opposer.

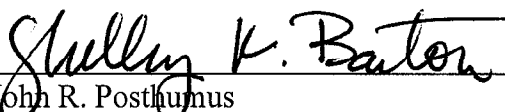
WHEREFORE, Opposer RE/MAX INTERNATIONAL, INC. prays that this opposition be sustained, that U.S. Service Mark Application Serial No. 75/983,359 for ROMAX be rejected, and that registration by Applicant be refused and denied.

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

The Director is hereby authorized to charge the \$300.00 fee to Deposit Account No. 502775. If there are any additional fees due, the Director is hereby authorized to charge such additional fees to Deposit Account No. 502775.

Respectfully submitted this 22nd day of November, 2004.

GREENBERG TRAURIG, LLP

By: 
John R. Posthumus
Gayle L. Strong
Shelley K. Barton
1200 17th Street, Suite 2400
Denver, Colorado 80202
(303) 572-6500

ATTORNEYS FOR OPPOSER

EXHIBIT A



Nº 1139014

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

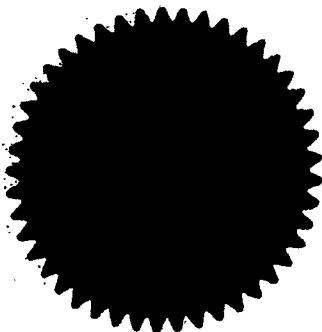
And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.



In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this twenty-sixth day of August, 1980.

S. Quincy D. Simmons

COMMISSIONER OF PATENTS AND TRADEMARKS

NOTICE

This Registration will be canceled by the Commissioner of Patents and Trademarks at the end of six years following the date of registration, unless within one year next preceding the expiration of such six years, the registrant files in the Patent and Trademark Office an affidavit showing that said mark is still in use or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. A fee of \$10.00 for each class must accompany the affidavit.

Int. Cls.: 35 and 36

Prior U.S. Cl.: 101

Reg. No. 1,139,014

Registered Aug. 26, 1980

United States Patent and Trademark Office

SERVICE MARK

Principal Register

RE/MAX

**Re/Max of America, Inc. (Colorado corporation)
5535 S. Trenton Way
Englewood, Colo. 80110**

**For: RENDERING TECHNICAL AID AND ASSIST-
ANCE TO OTHERS IN THE ESTABLISHMENT AND
OPERATION OF A REAL ESTATE BROKERAGE
AGENCY, in CLASS 35 (U.S. CL. 101).**

First use Jan. 30, 1973; in commerce Jun. 1, 1973.

**For: REAL ESTATE BROKERAGE SERVICES, in
CLASS 36 (U.S. CL. 101).**

First use Jan. 30, 1973; in commerce Jun. 1, 1973.

Ser. No. 113,283. Filed Jan. 21, 1977.

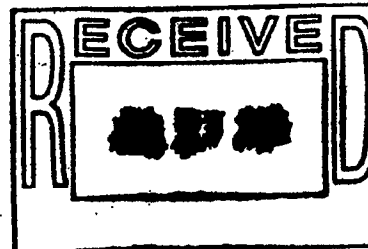
MARC BERGSMAN, Primary Examiner



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

REGISTRATION NO: 1139014 SERIAL NO: 73113283 MAILING DATE: 07/09/2001
REGISTRATION DATE: 08/26/1980
MARK: RE/MAX
REGISTRATION OWNER: RE/MAX INTERNATIONAL, INC.
CORRESPONDENCE ADDRESS:

GARY L. WEIL, ESQ.
RE/MAX INTERNATIONAL, INC.
8390 EAST CRESCENT PARKWAY
SUITE 600
GREENWOOD VILLAGE, CO 80111-2800



NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

NOTICE OF RENEWAL

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
035 036.

HENSON, EVERETT J
PARALEGAL SPECIALIST
POST-REGISTRATION DIVISION
(703)308-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION
CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION



Nº 1339510

THE UNITED STATES OF AMERICA

CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

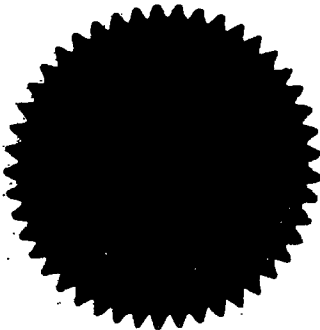
And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for Twenty Years unless sooner terminated as provided by law.



In Testimony Whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this fourth day of June, 1985.

Acting Commissioner of Patents and Trademarks

NOTICE

This Registration will be canceled by the Commissioner of Patents and Trademarks at the end of six years following the date of registration, unless within one year next preceding the expiration of such six years, the registrant files in the Patent and Trademark Office an affidavit showing that said mark is in use in Commerce or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. A fee of \$100.00 for each class must accompany the affidavit.

Int. Cl.: 36

Prior U.S. Cl.: 102

United States Patent and Trademark Office

Reg. No. 1,339,510

Registered June 4, 1985

**SERVICE MARK
PRINCIPAL REGISTER**

RE/MAX

**RE/MAX OF AMERICA, INC. (COLORADO
CORPORATION)
5251 S. QUEBEC
ENGLEWOOD, CO 80111**

**FOR: INSURANCE BROKERAGE SERVICES,
IN CLASS 36 (U.S. CL. 102).**

**FIRST USE 4-1-1980; IN COMMERCE
4-1-1980.**

OWNER OF U.S. REG. NO. 1,139,014.

SER. NO. 510,503, FILED 11-26-1984.

SHARON R. MARSH, EXAMINING ATTORNEY

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,403,626

Registered Nov. 14, 2000

**SERVICE MARK
PRINCIPAL REGISTER**

RE/MAX

**RE/MAX INTERNATIONAL, INC. (COLORADO COR-
PORATION)
8390 EAST CRESCENT PARKWAY, SUITE 600
GREENWOOD VILLAGE, CO 80111**

FIRST USE 8-1-1995; IN COMMERCE 8-1-1995.

**OWNER OF U.S. REG. NOS. 1,139,014, 2,119,607
AND OTHERS.**

**FOR: PROVIDING A WEBSITE ON GLOBAL COM-
PUTER NETWORKS FEATURING INFORMATION IN
THE FIELD OF REAL ESTATE, IN CLASS 36 (U.S.
CLS. 100, 101 AND 102).**

SER. NO. 75-712,611, FILED 5-24-1999.

CAROLINE WEIMER, EXAMINING ATTORNEY

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Director of the United States Patent and Trademark Office; and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Director of the United States Patent and Trademark Office

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

Reg. No. 2,468,858

United States Patent and Trademark Office

Registered July 17, 2001

**TRADEMARK
PRINCIPAL REGISTER**

RE/MAX

RE/MAX INTERNATIONAL, INC. (COLORADO
CORPORATION)
8390 EAST CRESCENT PARKWAY
SUITE 600
GREENWOOD VILLAGE, CO 80111

FOR: COMPUTER SOFTWARE, NAMELY A CD ROM THAT ENABLE USERS TO ASK FOR AND RECEIVE BUSINESS INFORMATION IN THE NATURE OF OFFICE ADDRESSES, PHONE AND FACSIMILE NUMBERS, AS WELL AS LANGUAGES SPOKEN BY, AND PRIMARY REAL ESTATE SPECIALIZATION OF, INDIVIDUAL REAL ESTATE AGENTS; CD ROM ACCOUNTING AND BILLING SOFTWARE; A CD ROM MULTIMEDIA HOME LISTING PRESENTATION THAT PROVIDES INFORMATION ON MARKETING STRATEGIES FOR PROPERTY, WITH CALENDARING AND PROPERTY COMPARISON FEATURES; A CD ROM THAT PROVIDES INFORMATION ON CRIME STATISTICS, EDUCATIONAL OPPORTUNITIES, AND OTHER DEMOGRAPHIC INFORMATION REGARDING NEIGHBORHOODS THROUGHOUT

THE UNITED STATES; AN INFORMATIONAL CD ROM ON HOW TO RECRUIT REAL ESTATE AGENTS; AN INFORMATIONAL CD ROM ON HOW TO ENHANCE PRODUCTIVITY OF REAL ESTATE AGENTS WHICH ENABLES A USER TO SCHEDULE AND CALENDAR EVENTS, AND TRACK CONTACTS AND HOME LISTING INFORMATION IN DATABASES; AND A CD ROM WITH CALENDARING AND TRACKING FEATURES THAT PROVIDES INFORMATION ON HOW TO OPERATE AND MANAGE A REAL ESTATE OFFICE; ALL IN THE REAL ESTATE INDUSTRY, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 3-1-1989; IN COMMERCE 3-1-1989.

OWNER OF U.S. REG. NOS. 1,139,014, 2,119,607 AND OTHERS.

SER. NO. 75-702,664, FILED 5-10-1999.

CAROLINE WEIMER, EXAMINING ATTORNEY

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

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A copy of the Mark and pertinent data from the application are part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Nicholas P. Erdici

Acting Director of the United States Patent and Trademark Office

Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,106,387

United States Patent and Trademark Office

Registered Oct. 21, 1997

**SERVICE MARK
PRINCIPAL REGISTER**

REMAX

RE/MAX INTERNATIONAL, INC. (COLORADO
CORPORATION)
5445 DTC PARKWAY, SUITE 1200
ENGLEWOOD, CO 80155

FIRST USE 1-1-1977; IN COMMERCE
1-1-1977.

OWNER OF U.S. REG. NO. 1,339,510.

SER. NO. 75-068,799, FILED 3-7-1996.

FOR: REAL ESTATE BROKERAGE SERV-
ICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

RUSS HERMAN, EXAMINING ATTORNEY

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

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The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office, that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are a part of this certificate.

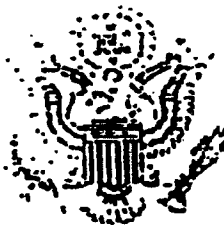
This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Bence Lehman

Commissioner of Patents and Trademarks

The United States of America



**CERTIFICATE OF REGISTRATION
PRINCIPAL REGISTER**

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A copy of the Mark and pertinent data from the application are a part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Bence Lehman

Commissioner of Patents and Trademarks

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,054,698

United States Patent and Trademark Office

Registered Apr. 22, 1997

**SERVICE MARK
PRINCIPAL REGISTER**

REMAX

**RE/MAX INTERNATIONAL, INC. (COLORADO
CORPORATION)
5445 DTC PARKWAY, SUITE 1200
ENGLEWOOD, CO 80111**

**FOR: FRANCHISE SERVICES, NAMELY, OF-
FERING TECHNICAL ASSISTANCE IN THE
ESTABLISHMENT AND/OR OPERATION OF
REAL ESTATE BROKERAGE FIRMS, IN
CLASS 35 (U.S. CLS. 100, 101 AND 102).**

**FIRST USE 1-1-1977; IN COMMERCE
1-1-1977.**

**OWNER OF U.S. REG. NOS. 1,139,014 AND
1,173,386.**

SER. NO. 75-068,927, FILED 3-7-1996.

RUSS HERMAN, EXAMINING ATTORNEY